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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,175	12/08/2003	Richard J. Schneider	IGT1P328/AC00054-001	5055

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EXAMINER	
NGUYEN, THUY-VI THI	

ART UNIT	PAPER NUMBER
3689	

NOTIFICATION DATE	DELIVERY MODE
12/09/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTO@wavsip.com

Office Action Summary	Application No.	Applicant(s)	
	10/731,175	SCHNEIDER, RICHARD J.	
	Examiner	Art Unit	
	THUY-VI NGUYEN	3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 August 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-45* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-45* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August, 27, 2009 has been entered.

Response to Amendment

2. This is in response to the applicant's communication filed on August, 27, 2009, wherein:

Claims 1-45 are currently pending;

Claims 1, 35, 38, 41, 45 have been amended;

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-37 are rejected under 35 U.S.C. 101 because in order for a method to be considered a "process" under §101, a claimed process must either:

(1) be tied to another statutory class (such as a particular apparatus) or

(2) transform underlying subject matter (such as an article or materials). See *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9

(1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

Presently, applicant does recite a tie to another statutory class as shown on steps (b) and (d) by tracking gaming machine payout data (first step); storing a record (second step), but this tie is nominal. Examiner considers these steps to be extra-solution activity since they are basically just tracking and storing *data*. With respect to claims 1-37, the claim language does not include the required tie or transformation and thus is directed to nonstatutory subject matter.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1-8, 15-22, 28-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over PETERSON (US 2003/0220139) in view of O'DONOVAN ET AL (US 2003/0195031).

As for independent claim 1, PETERSON discloses a method for communicating a report concerning a gamming machines' past payout data to a player, comprising:

a) tracking gaming machine payout

{see par. 0009, lines 7-17; par. 0018, lines 9-13; par. 0022 and figures 3-6 e.g. "collects the machine's current or historical jackpot winning information"};

b) storing gaming machine payout data;

{see pars 0018-0019, 0022, figures 2-4}

e) generating a report based on the selected payout data, a report including comparative past payout data which allows the player to identify a gaming machine from among a plurality of gaming machines that is more likely to produce an outcome to desired by the player;

{see pars. 0002, 0009, 0018; figures 4 and 6 wherein PETERSON discloses generating gaming information/report including comparative past payout data. For example: e.g. "display the activities of gambling machines/report /or gaming machines' individual jackpot winning information to customers/player for viewing. The jackpot information /payout are collected including the time and date of the last jackpot awarded, and the number of jackpots awarded within a selected time period and their amounts}.

f) communicating to the player the generated report;

{see figures 4-6; pars. 0002, 0009, 0018 discloses the gaming information/report such as winning information/payout for each gaming machine is provided or displayed to the player}.

Note: For convenience, steps (a)-(f) are added at the beginning of each step.

PETERSON discloses the claimed invention as indicated above. For example, PERSON discloses the generating the past payout information of each gamming machine such as information about the last payout data, or the number of jackpots for a particular machine has recently awarded and display/provide this information to the player or customer. This is considered as giving or providing a customer a selection to decide which gaming machine/product may have a better out come or better chance to win.

However, PETERSON discloses the generating and displaying the winning/past payout information without the interactive or communication between the player/user and the system of generating the report such as "*user input or select criteria or parameter relating to the payout data*" (step c); and "*selecting based on the accepted criteria, particular payout data from the record of the payout data*" (step d).

In a similar method of interactive communication for **providing or suggesting product that is suitable for the player**, O'DONOVAN ET AL discloses a known technique of communicating/displaying the product data to the user, accepting from player to the input various configuration criteria, e.g. frequency of payout data, size of

jackpots, game theme, bonus games, and selecting/matching the inputted desired characteristics with previously configured default games parameters stored in a memory. The game configuration parameters is selected or suggested are most closely associate with the player input criteria and also the players' personal history {see O'DONOVAN ET AL at least figures 2-3; pars. 0009, 0017-0018, 0022, 0033}

Therefore, it would have been obvious to a skilled artisan to modify the teachings of **PETERSON** to include the features taught by **O'DONOVAN ET AL** in order to provide or suggest product/gaming information that is suitable for the customer as indicated above as well as satisfy the multiple requests for popular and/or different user requests, offering the multiple gaming machines in a variety of configuration combinations will help to reduce the lose interest and discontinue gaming from the player { O'DONOVAN ET AL, pars. 0004-0005}. Note that the combination above would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such providing or suggesting the desired product that is suitable for the customer. The difference in the type of product information in the communication exchange is immaterialized.

As for dep. claims 2-4, which disclose the tracking payout data/information including the tracking winning events, time of winning event and particular hand types, this is taught in PETERSON {see par. 0009; par. 0018 and figure 4}.

As for dep. claim 5, which discloses the tracking gaming machines' typical payout data, selecting a time period, and comparing the gaming machine's typical

payout data to the machines' payout data for the selected time period, this is taught in PETERSON, pars. 0018-0019, and figure 4}.

As for dep. claims 6-8 which disclose the communicating to the player the report is a visual report, this visual report is communicated through a display associated with the gamming machine, and also the visual report is communicated through a terminal remote from the gamming machine. This is taught in PETERSON, {see pars. 0018-0021 and figures 2, 4 and 6}.

As for dep. claims 15-16, which discloses the different type of report/information to the player, e.g. custom report, standard report, this is fairly taught in PETERSON, see figures 4, par. 0018, 0022.

As for dep. claims 17-18, which discloses the communication the report to the player before the player enters a game floor, and through electronic means, this is taught in PETERSON, see pars. 0021-0022, figures 3 and 6}.

As for dep. claims 19-22, which discloses the report is communicated to a plurality of players and also to a subset of the plurality of players e.g. existing player, this is taught in PETERSON, see pars. 0002, 0022, figures 3-6}.

As for dep. claim 28-34, which disclose the record/information corresponding to a selected time period, the record is an elapsed time between specific payouts, the selected time period is configured by the user, the record is comprise information corresponding to a number of plays between winning events and a particular outcomes, an a record derived from a plurality of gaming machines, this is taught in PETERSON. See pars. 0018-0022 and figure 4.

Moreover, type of information/data/record, have been determined to be non-functional descriptive material (NFDM), thus having no patentable weight and does not need to be taught by the prior art. Nonfunctional descriptive material can not render nonobvious an invention that would have other wise been obvious. In re Gulack, 703 F. 2d 1381, 1385, 217 USPQ 401, 40-4 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability. See MPEP 2106.01.

As for independent claim 35, basically this claim carries the similar limitations as the rejected independent claim 1 above. Therefore, it is rejected for the same reason sets forth the rejected independent claim 1 as indicated above.

As for dep. claims 36-37, basically these claims have the similar limitations as the rejected dep. claims 15-16 above. Therefore, they are rejected for the same reason sets forth dep. claims 15-16 as indicated above.

As for independent claim 38, basically this is a system claim which carries out the method step of the rejected independent claim 1 above. Therefore, it is rejected for the same reason set forth the rejected independent claim 1 as indicated above.

As for dep. claims 39-40, which discloses a gaming machines and a network interconnecting the plurality of gaming machines including a display, this is taught in PETERSON see pars. 0018-0022, figures 3-6.

As for independent claim 41, PETERSON discloses a system for displaying past payout data of a gaming machine comprising: a plurality of gaming machines include a display, a server coupled to the plurality of gamming machines {see pars.

0018-0022, figures 2-6}. Basically this is a system claim which carries a similar step as the rejected independent claim 1 above. Therefore, it is rejected for the same reason sets forth independent claim 1 as indicated above.

As for dep. claim 42, which discloses an access controller for the user to access/view to product information, this is taught in O'DONOVAN ET AL, see pars. 0009, 0026.

As for dep. claims 43-44, which discloses the type of gaming machines e.g. hot or cold, this is fairly taught in PETERSON, see figure 4.

As for independent claim 45, which discloses a computer program product, stored on a processor readable medium, including instructions operable to cause a computer system on a gaming network to perform a method for communicating a report concerning gaming machine past payout data to a player, basically this claim carries the similar limitation as independent claim 1 above. Therefore, it is rejected for the same reason sets forth the rejected independent claim 1 as indicated above.

7. Claims 9-14, 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over PETERSON (US 2003/0220139) in view of O'DONOVAN ET AL (US 2003/0195031) and further in view of ROWE ET AL (US 2003/0013527).

As for dep. claim 9-14, PETERSON as modified by O'DONOVAN ET AL discloses the invention substantially as claimed as discussed above. However, PETERSON/ O'DONOVAN ET AL doesn't mention the how the report/information is communicated to the player, e.g. the report/information is printed at the gamming

machine, the report/information is aural report/information, the report/information is communicated over the speaker associated with the gamming machine, or remote from the gamming machine.

ROWE ET AL discloses the generating and providing information/report (e.g. bonus, award, promotion) from the host system to the player tracking device by the network, the tracking device such as player tracking device controller, a card reader, display, keyboard, printer and speaker. {see ROWE ET AL, pars. 0009-0012; 0015, 0067 and at least figures 2-4}.

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the teachings of PETERSON/ O'DONOVAN ET AL to including the feature taught by ROWET AL in order to target a player while the player is playing so that the player can play longer or more often.

As for dep. claims 23-27, PETERSON as modified by O'DONOVAN ET AL discloses the invention substantially as claimed as discussed above. ROWE ET AL discloses the report include the color code or symbol. {see pars. 0029, 0067, 0069}. Moreover, the type of color code/data in the report as been determine as Nonfunctional Descriptive Material. See MPEP 2106.01.

Response to Arguments

8. Applicant's arguments with respect to claims 1-45 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy-Vi Nguyen whose telephone number is 571-270-1614. The examiner can normally be reached on Monday through Thursday from 8:30 A.M to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./

Examiner, Art Unit 3689

/Tan Dean D. Nguyen/
Primary Examiner, Art Unit 3689
12/5/09